

Serial No.: 09/872,226  
Attorney Docket No.: 10008157-1

### **REMARKS**

In response to the Office Action dated July 3, 2006, claims 1, 4, 10, 11, 15, 19 and 22 have been amended and claims 14 and 23 have been canceled. Claims 1-13, 15-22 and 24 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action objected to claims 14 and 23 as being of improper dependent form for allegedly failing to further limit the subject matter of a previous claim.

In response, the Applicants have canceled claims 14 and 23 to overcome this objection.

The Office Action rejected claims 10-18 under 35 U.S.C. § 112, second paragraph.

In response, the Applicants have amended claims 10-18 as suggested by the Examiner to overcome these rejections.

The Office Action rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374) in view of Zehr (U.S. Patent Publication No. 2001/0025274).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

Specifically, the Applicants' independent claims now include receiving user data from the service provider for programmatically and automatically determining for advertisers an advertising potential value of advertisements to help advertisers decide about advertisement placement in the hardcopy. Support for these amendments can be found throughout the specification and at least in FIGS. 1-3 and paragraphs [0019], [0023], [0031], [0032] and [0034] of the Application specification (U.S. Patent Publication No. 2002/0184092).

In contrast, the combined references merely disclose personalizing and customizing publications using subscriber profile preferences (see Figs. 1-5, paragraphs

[0012], [0079], [0083], the Abstract and the Summary of Kent et al.) and automatically reducing the cost of sending an item by inserting advertisements having monetary value (see Abstract, Figs. 2-5, paragraph [0043] and the Summary of Zehr et al.).

Although the combined references disclose having an advertiser "bid-up" for a spot if the advertiser feels certain ads to certain types of people are worth more than others (see paragraph [0043] of Zehr et al.), this is very different from the Applicants' claimed programmatically and automatically determining for advertisers an advertising potential value of advertisements to help advertisers decide about advertisement placement in the hardcopy. Instead, the combined references explicitly state that an advertiser can manually "bid-up" for a spot "...meaning whether an advertiser has indicated within the ad order processor 76 that placement of certain ads to certain types of people are worth more than others" based on their own discretion (see paragraph [0043] of Zehr et al.). However, an advertising potential value for advertisements is not programmatically and automatically determined for the advertiser to help decide about placing advertisements in the hardcopy, like the Applicants' claimed invention.

Therefore, among other things, the combined references do not disclose, teach or suggest the Applicants' claimed receiving user data from the service provider for programmatically and automatically determining for advertisers an advertising potential value of advertisements to help advertisers decide about advertisement placement in the hardcopy. Thus, since the combined references are missing features of the Applicants' claimed invention, the combined references cannot render the Applicants' invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicants' claimed invention indicates a lack of a prima facie case of obviousness and, thus, the rejections should be withdrawn (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the

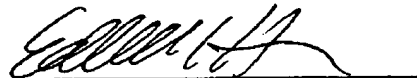
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amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly **request** the Examiner to telephone the Applicants' attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to

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